

ESTTA Tracking number: **ESTTA427405**

Filing date: **08/26/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Yousendit, Inc.
Granted to Date of previous extension	08/28/2011
Address	1919 S. Bascom Ave., 3rd Floor Campbell, CA 95008 UNITED STATES
Attorney information	Lisa M. Martens Fish & Richardson P.C. P.O. Box 1022 Minneapolis, MN 55440-1022 UNITED STATES tmdoctc@fr.com, lmm@fr.com, enh@fr.com

Applicant Information

Application No	77817716	Publication date	03/01/2011
Opposition Filing Date	08/26/2011	Opposition Period Ends	08/28/2011
Applicant	DROPBOX, INC. 153 KEARNY STREET, MEZZANINE SAN FRANCISCO, CA 94108 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 009.</p> <p>All goods and services in the class are opposed, namely: Computer software and downloadable computer software used to store and share data, documents, files, information, text, photos, images, graphics, music, audio, video, and multimedia content with others via global computer networks, mobile telephones, and other communications networks for the purpose of file back up and synchronization, not including software for use in database management in the field of life sciences research or software for uploading or transferring advertising programs and media advertising communications</p>
<p>Class 039.</p> <p>All goods and services in the class are opposed, namely: Storage of electronic media, namely, data, documents, files, text, photos, images, graphics, music, audio, video, and multimedia content</p>
<p>Class 042.</p> <p>All goods and services in the class are opposed, namely: Providing temporary use of non-downloadable computer software used to store and share data, documents, files, information, text, photos, images, graphics, music, audio, video, and multimedia content with others via global computer networks, mobile telephones, and other communications networks for the purpose of file back up and synchronization, not including software for use in database management in the field of</p>

biomedical research or software for uploading or transferring advertising programs and media advertising communications; hosting of digital content on the internet

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	DROPBOX		
Goods/Services	Solutions for large file transfer, storage and sharing of data.		

Attachments	DROPBOX - Opposition.pdf (7 pages)(360129 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/s/ Lisa M. Martens
Name	Lisa M. Martens
Date	08/26/2011

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No. 77/817,716
For the mark DROPBOX
Published in the *Official Gazette of Trademarks* on March 1, 2011

YouSendIt, Inc.,

Opposer,

vs.

Dropbox, Inc.,

Applicant.

Opposition No.

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Arlington, Virginia 22313-1451

NOTICE OF OPPOSITION

Opposer, YouSendIt, Inc., located and doing business at 1919 S. Bascom Avenue, 3rd Floor, Campbell, CA 95008 (hereafter, "Opposer"), believes that it will be damaged by the registration of the designation DROPBOX identified in Application Serial No. 77/817,716 (hereafter, the "Application"), filed by Dropbox, Inc., (hereafter, "Applicant"), and, having previously filed for and been granted two extensions of time to oppose the Application, hereby opposes the same.

GROUND FOR OPPOSITION

1. Opposer was founded in 2004, and is a global leader in cloud-collaboration services with an integrated approach for sending, sharing, and signing documents on-line. Opposer has offered and offers its services in the United States and elsewhere, serving a global customer base.

2. Since long before September 1, 2009, the filing date of the Application, any use or constructive use of Applicant's designation DROPBOX shown in the Application, or any priority date that could be claimed with respect to the Application, Opposer has offered, and currently offers, solutions for large file transfer, storage, and sharing of data in the United States and elsewhere.

3. Since long before September 1, 2009, the filing date of the Application, any use or constructive use of Applicant's designation DROPBOX shown in the Application, or any priority date that could be claimed with respect to the Application, Opposer adopted and commenced use of the mark DROPBOX in connection with its solutions for large file transfer, storage and sharing of data. Since then, Opposer continuously has used the DROPBOX mark in the United States and elsewhere in connection with its solutions for large file transfer, storage and sharing of data.

4. Since long before September 1, 2009, the filing date of the Application, any use or constructive use of Applicant's designation DROPBOX shown in the Application, or any priority date that could be claimed with respect to the Application, Opposer has advertised and promoted its DROPBOX mark extensively in connection with its solutions for large file transfer, storage and sharing of data, and has achieved significant sales in connection with these services under and in connection with its DROPBOX mark in the United States and elsewhere.

5. Applicant applied to register the mark DROPBOX on September 1, 2009, based on its alleged *bona fide* intent to use the mark in United States commerce, in connection with the following goods and services:

- “[c]omputer software and downloadable computer software used to store and share data, documents, files, information, text, photos, images, graphics, music, audio, video, and multimedia content with others via global computer networks, mobile telephones, and other communications networks for the purpose of file back up and synchronization, not including software for use in database management in the field of life sciences research or software for uploading or transferring advertising programs and media advertising communications” in International Class 9;
- “[s]torage of electronic media, namely, data, documents, files, text, photos, images, graphics, music, audio, video, and multimedia content” in International Class 39; and
- “[p]roviding temporary use of non-downloadable computer software used to store and share data, documents, files, information, text, photos, images, graphics, music, audio, video, and multimedia content with others via global computer networks, mobile telephones, and other communications networks for the purpose of file back up and synchronization, not including software for use in database management in the field of biomedical research or software for uploading or transferring advertising programs and media advertising communications; hosting of digital content on the internet” in International Class 42.

(Hereafter, “Applicant’s Goods and Services”).

6. Opposer’s common law rights in and to its DROPBOX mark precede September 1, 2009, the filing date of the Application, any use or constructive use of Applicant’s designation DROPBOX shown in the Application, and any priority date that could be claimed with respect to the Application.

7. Opposer’s DROPBOX mark is distinctive and has been in use long before September 1, 2009, the filing date of the Application, any use or constructive use of Applicant’s designation DROPBOX shown in the Application, or any priority date that could be claimed with respect to the Application.

8. Applicant's Goods and Services overlap with and are closely related, if not nearly identical, to the services Opposer offers and provides under its DROPBOX mark, for which Opposer has prior and superior rights.

9. Upon information and belief, Applicant's Goods and Services will be advertised and sold in the same or similar types of media and trade channels as the solutions for file transfer, storage, and sharing of data that Opposer offers and provides under its DROPBOX mark, for which Opposer has prior and superior rights.

10. Upon information and belief, Applicant's Goods and Services will be offered and sold to the same or similar types of customers who use the services that Opposer offers and provides under its DROPBOX mark, for which Opposer has prior and superior rights.

11. Applicant's designation DROPBOX identified in the Application is identical to Opposer's DROPBOX mark, for which Opposer has prior and superior rights in connection with solutions for file transfer, storage, and data sharing, that, when applied to Applicant's Goods and Services, it is likely to cause confusion, to cause mistake or to deceive, with resulting injury to Opposer, the trade and the public, all in violation of Section 2(d) of the United States Trademark Act, 15 U.S.C. § 1052(d).

12. Opposer will be damaged by the registration sought herein by Applicant because such registration will support and assist Applicant in the confusing, misleading, and deceptive use of the DROPBOX designation shown in the Application, and will give color of exclusive statutory rights in Applicant in violation and derogation of the prior and superior rights of Opposer in its DROPBOX mark.

13. Consumers familiar with Opposer's DROPBOX mark are likely to mistakenly believe that Applicant's Goods and Services are sponsored, authorized, associated with, or otherwise approved by Opposer because the designation DROPBOX identified in the Application is identical to Opposer's DROPBOX mark. Inferior quality, deficiencies, or other faults in Applicant's Goods and Services are likely to reflect negatively upon, tarnish, and seriously injure the reputation that Opposer has established for the services marketed and provided under its DROPBOX mark. This is likely to result in loss of revenues to Opposer and damage to Opposer's reputation.

14. Applicant's intended use of the designation DROPBOX is likely to falsely suggest a relationship between Applicant's Goods and Services and Opposer's services. Such intended use of the designation DROPBOX is likely to cause confusion, mistake, or deception with respect to the source or sponsorship of Applicant's Goods and Services. Such intended use is thus likely to cause a significant increase in the level of Applicant's sales due to consumers' likely mistaken belief that Opposer is the source or sponsor of Applicant's Goods and Services. Applicant's intended use of the designation DROPBOX is likely to result in Applicant's trading off and benefiting from the goodwill associated with Opposer, resulting in improper gains by Applicant.

15. For the foregoing reasons, the registration sought by Applicant is contrary to the provisions of Sections 2(d) and 43(a) of the United States Trademark Act, 15 U.S.C. §§ 1052(d) and 1125(a), and Opposer would be damaged thereby.

16. In order to protect the public against confusion and deceit, and to protect Opposer's DROPBOX mark from infringement and unfair competition, registration of the

designation DROPBOX shown in the Application should be refused under Sections 2(d), 43(a), and 13 of the United States Trademark Act, 15 U.S.C. §§ 1052(d), 1125(a), and 1063.

WHEREFORE, Opposer respectfully prays for the following:

- a. a finding that Opposer has priority as to Applicant's designation DROPBOX identified in the Application in connection with Applicant's Goods and Services;
- b. a finding that Applicant's designation DROPBOX identified in the Application is likely to cause confusion with Opposer's DROPBOX mark; and
- c. under Section 13 of the United States Trademark Act, 15 U.S.C. § 1063, that this opposition be sustained and the designation DROPBOX identified in the Application be refused registration.

This Notice of Opposition is submitted electronically. Please apply the \$900 fee to Deposit Account No. 06-1050, making reference to 30821-0002001.

Respectfully submitted,

Dated: R-26-11



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CERTIFICATE OF SERVICE

The undersigned hereby certified that a copy of the foregoing NOTICE OF OPPOSITION has this 26th day of August, 2001 been mailed by prepaid first class mail to the below-identified Attorney at his/her place of business:

John L. Slafsky
Wilson Sonsini Goodrich & Rosati
650 Page Mill Road
Palo Alto, CA 94304


Alexandra Uebbing